

***AMENDMENT UNDER 37 C.F.R. § 1.111***  
***U. S. Application No. 09/863,476***

**REMARKS**

Claims 1-13 are all the claims pending in the application, including new claims 12 and 13 added by the present Amendment.

Claims 1-11 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1-11 are rejected under 35 U.S.C. § 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Watanabe et al. (US 6,578,072). Claims 6-9 and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by “Article 9/1996” (J. O’Neill, “Photofinishers Shoot the Curl in Cyberspace,” Photographic Trade News, Sept. 1996).

Applicant respectfully traverses the rejections with the following comments.

For the indefiniteness rejection, Applicant submits that the claims clearly define “an image printer” and “a voucher printer” as separate features of the claims. These printers do not represent the same printer having different names. For example, the specification of the present invention describes these printers at page 3, line 19 - page 4, line 4. Hence, Applicant submits that the recitation of the image printer and the voucher printer does not render the claims indefinite.

Turning to the prior art rejections, Applicant has the following comments.

Watanabe relates to a network photograph service system which provides various kinds of services using an image disclosed on a network. The system includes an image recording means for recording a plurality of images therein; an image selecting means for enabling a user

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of the service to select from images which the user can browse one or a plurality of images belonging to an image group by enabling the name of the image group having been pre-registered and the images recorded in the image recording means to be seen on the network; an image group managing means for managing the image group by recording a correspondence between the name of the image group and the image selected as an image belonging to the image group; and a grouped image disclosing means for enabling, based on the recorded correspondence, a user of the service to browse on the network only images belonging to an image group out of the images recorded in the image recording means when the name of the image group is specified by the user.

Applicant submits that Watanabe fails to teach or suggest the voucher printer claimed in claim 1. The Examiner cites numerous portions of the reference as well as FIG. 2 as allegedly disclosing the features of claim 1, however, the cited portions of the reference do not teach or suggest a voucher printer. In claim 1, there is a voucher printer which prints a voucher including thumbnail images and details of an order on the basis of the order information, the thumbnail images corresponding to image data which have been accepted by the order acceptance machine and have been transferred to the image printer. The cited portions of Watanabe do not disclose such a voucher printer. Rather, the reference discloses an image printer. As disclosed in col. 5, lines 52-55, a mini-laboratory 3 develops film, reads the developed film using a scanner 7, and carries out a simultaneous printing service which generates prints by using printer 9. As disclosed in col. 6, lines 54-56, the printer 9 of the reference prints processed image data. By contrast, the reference does not disclose the voucher printer as claimed in claim 1. Therefore, claim 1 and its dependent claims 2-5 are allowable over Watanabe, for at least this reason.

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For reasons analogous to those presented above in relation to claim 1, Applicant submits that claim 10 is allowable over Watanabe also.

With respect to claim 6, Applicant submits that prior art fails to teach or suggest an electronic mail transmission means as claimed in claim 6. The electronic mail transmission means of claim 6 transmits, to a person who has placed an order and in the form of an electronic mail, the order information and thumbnail images of the images which have been accepted by the order acceptance machine and transferred to the image printer. The Examiner asserts that all of the limitations of claim 6 are disclosed in col. 6, lines 27-40, of Watanabe, but Applicant disagrees. In particular, the Examiner refers to lines 27-38, which disclose that services are provided in a form of web pages by a “www” application server 15. Also disclosed is that a plug-in 22 for a digital photographic service which enables browsing, downloading, and ordering printing of registered images, is provided to a user. Thus, the reference only discloses an image printer. However, the reference does not disclose an electronic mail transmission means which transmits the order information and thumbnail images in the form of an electronic mail, as recited by claim 6 of the present invention. Clearly, the reference fails to disclose this feature of claim 6. Therefore, claim 6 and its dependent claims 7-9 are not anticipated by Watanabe.

Essentially, the Examiner concedes that the electronic mail transmission means of claim 6 is not disclosed in the reference, by asserting that the use of e-mail would have been obvious in the system of Watanabe. However, Applicant submits that there is no teaching or suggestion in the reference of modifying Watanabe’s system to include the electronic mail transmission means recited in claim 6 of the present invention.

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Simply because the use of e-mail may have been considered known in the art does not render obvious the electronic mail transmission means as recited in claim 6. Rather, Applicant submits that modifying the system of Watanabe to add the electronic mail transmission means of claim 6 would not have been obvious to one of ordinary skill of the art at the time of the invention.

Watanabe discloses that the user can browse thumbnail images by accessing a web page and request various kinds of digital photographic services (col. 6, lines 32-38). However, providing an electronic mail transmission means which transmits, to a person who has placed an order and in the form of an electronic mail, the order information and thumbnail images of the images which have been accepted by the order acceptance machine and transferred to the image printer would change the principle operation of the Watanabe system. This is the case, because Watanabe contemplates a system in which the user can browse thumbnail images and order photographic services via a web page, but the reference does not provide a means for transmitting the order information and thumbnail images to the user. Rather, the web page is simply used for placing orders and viewing thumbnail images in order to facilitate the ordering process. The reference discloses that an order file 14 is generated and transferred to the application server 15 of the center server 12. See col. 6, lines 39-44. Watanabe does not provide any means by which to transmit to the user in form of electronic mail, or otherwise, the order information and thumbnail images which have been accepted by the order acceptance machine and transferred to the image printer. Therefore, claim 6 and its dependent claims 7-9 are not obvious over Watanabe.

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For claim 11, Applicant submits that claim 11 is allowable over the prior art for analogous reasons to those presented above for claim 6.

With respect to the rejection of claims 6-9 and 11 under 35 U.S.C. § 102(b) as being anticipated by Article 9/1996, Applicant submits that these claims are not anticipated by the reference. Specifically, Article 9/1996 does not teach or suggest the electronic mail transmission means recited in claim 6. In the reference, it is disclosed that an e-mail message could be sent to a customer, which says "Your photos are ready!" However, this disclosure is not the same as, and does not correspond to, the claimed electronic mail transmission means which transmits, to a person who has placed an order and in the form of an electronic mail, the order information and thumbnail images of the images which have been accepted by the order acceptance machine and transferred to the image printer. Furthermore, the cited excerpt states that the photo finisher personnel, not an electronic mail transmission means, would send the e-mail to the customer. Thus, an electronic mail transmission means which transmits the electronic mail is not disclosed, and also an electronic mail comprising the order information and thumbnail images is not disclosed. Hence, claims 6-9 are not anticipated by Article 9/1996.

Furthermore, claim 11 is not anticipated by Article 9/1996 for reasons analogous to those presented above for claim 6.

Additionally, new claims 12 and 13 are added to further define the present invention. Applicant submits that these claims are allowable over the prior art, at least because of their dependence from claims 6 and 11, respectively.


In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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